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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/680,361

10/07/2003

Jeffrey Dryer

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05/03/2006

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EXAMINER

O'CONNOR, CARY E

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/680,361

Applicant(s)

DRYER

Examiner

Cary E. O'Connor

Art Unit

3732

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24 and 25 is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1604</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 11, 12, 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Von Weissenfluh (5,195,889). Von Weissenfluh shows a dental instrument 2 comprising an actuating assembly, a first grasping member 2' having a first grasping surface 2''' and second grasping member 2'' having a second grasping surface 2^{IV} coupled to the actuating assembly at a transition area. The grasping assembly is adapted to conform to a desired contour (see Figure 4). Both members 2', 2'' has an apical seat near the top of its grasping surface to receive a projection of the matrix (see Fig. 4). The instrument facilitates manipulation of a dental matrix 1, to various locations (i.e. mesial interproximal, etc.) as it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. The term "facilitates" is considered to be equivalent to "adapted to". As to claims 5-8, the grasping surfaces are angled, or curved, to approximate the contour of the matrix, as can be seen in Figs. 3 and 4. One member 2'' is concavely curved on the grasping surface and convexly curved on the exterior surface while the other member 2' is concavely curved on the exterior surface and convexly curved on the

grasping surface. Because of this, the members are considered to be convexly and concavely curved. As to claims 11 and 12, the grasping assembly is permanently coupled to the actuating assembly. As to claim 21, the actuating assembly is bifurcated.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over von Weissenfluh (5,195,898). von Weissenfluh does not teach that the grasping assembly is removably coupled to the actuating assembly. However, to make these elements removably coupled is held to have been an obvious design choice. "It appears to us that the unity of diversity of parts would depend more upon the choice of the manufacturer, and the convenience and availability of the machines and tools necessary to construct the syringe, than on any inventive concept. In re Lockhart, 90 USPQ 214 (CCPA 1951).

Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over von Weissenfluh (5,195,898) in view of Mueller (6,095,815). von Weissenfluh does not teach the actuating assembly or the grasping assembly being curved or angled to facilitate exclusively distal manipulation of the appliance or exclusively mesial

manipulation of the appliance. Mueller shows a dental instrument wherein either the actuating assembly is angled (Figure 3) or the grasping assembly is angled (Figure 2) in order to achieve the most convenient angle for application of the appliance. It would have been obvious to one of ordinary skill in the art at the time the invention was made to angle or curve the actuating assembly or grasping assembly of von Weissenfluh, in view of Mueller, to facilitate exclusively distal manipulation of the appliance or exclusively mesial manipulation of the appliance.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over von Weissenfluh (5,195,898) in view of Silverstein (6,431,864). The actuating assembly of von Weissenfluh does not include a locking assembly. Silverstein shows dental instrument 1 having an actuating assembly. A locking assembly 6 is located on the actuating assembly to prevent the grasping members from opening. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the actuating assembly of von Weissenfluh with a locking assembly, as taught by Silverstein, in order to make handling of the instrument easier.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 5-14, 19-23 are rejected under the judicially created doctrine of double patenting over claims 7, 2-4, 7, 6, 8, 14-16, 9-12, 17, 18 and 13 of U. S. Patent No. 6,699,039 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the difference between the application claims and the patent claims lies in the fact that the patent claims include more elements and are thus much specific. Thus the invention of the patent claims are in effect a "species" of the "generic" invention of the application claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claims are anticipated by the patent claims, they are not patentably distinct from the patent claims.

Claims 1, 2, 6-8, 12, 23 are rejected under the judicially created doctrine of double patenting over claims 14 or 15 of U. S. Patent No. 6,776,616 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the difference between the application claims and the patent

claims lies in the fact that the patent claims include more elements and are thus much specific. Thus the invention of the patent claims are in effect a "species" of the "generic" invention of the application claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claims are anticipated by the patent claims, they are not patentably distinct from the patent claims.

Allowable Subject Matter

Claims 24 and 25 are allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 571-272-4715. The examiner can normally be reached on M-Th 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 571-272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cary E. O'Connor
Primary Examiner
Art Unit 3732

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